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EXAMINER

ALVAREZ, RAQUEL

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,628

Applicant(s)

KITCHEN ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 4/30/2004.
2. Claims 34-63 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 34-45 and 56-63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

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that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 34 and 56 clearly recite "useful, concrete and tangible results" ("presenting billing information"), however the claim recites no structural limitations (i.e., computer implementation), and so it fails the first prong of the test (technological arts).

The claims can be performed "by hand" or "manually with paper records" therefore it fails to pass the first prong technological arts test and therefore recites non-statutory subject matter under 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 34, 38, 41-43, 46, 50-51, 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (5,699,528 hereinafter Hogan).

With respect to claims 34, Hogan teaches a process for electronically presenting bills (Figure 11). Displaying, in a first portion of a single screen, a bill of a biller including at least one of a total amount, due date and a minimum amount due, and a payment due date (Figure 4); displaying, in a second portion of the single screen, bill

payment information including a payment date area for displaying a payment date, and a payment amount area for displaying a payment amount (Figure 4).

With respect to claim 38, Hogan further teaches that the displayed bill payment information includes a periodic payment area for displaying a periodicity at which further payments of the displayed payment amount are to be made after the displayed payment date (see figure 4, item 411).

With respect to claims 42-43, Hogan further teaches that the displayed bill payment information includes a payee area for displaying a payee name, and further comprising receiving a user command identifying a biller (i.e. the user clicks/identify the biller)(Figure 10); and automatically displaying a name of the identified biller as the payee name in the payee area (i.e. the biller identified will be the one displayed)(Figure 11); wherein the bill and the bill payment information are displayed in response to the identification of the biller)(Figures 10-11).

With respect to claims 46 and 51, Hogan teaches a system for electronically presenting bills authorizing payment (Abstract). A display configured to present in a first portion of a single screen, a bill of a biller including at least one of a total amount due and a minimum amount due and a payment due date (Figure 4), and in a second portion of the single screen, bill payment information including a payment date area for displaying a payment date, a payment amount area for displaying a payment amount (Figure 4), and a payment authorization indicator for authorizing payment of the displayed payment amount on the displayed payment date (see Figure 4, item 411); an input device for activating the payment authorization indicator (see Figure 4, 411); and a

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processor for generating a message to authorize payment on the displayed payment amount on the displayed payment date based on the activation of the payment authorization indicator (i.e. a message is sent authorizing the payment based on the user's selection)(see figure 4).

With respect to claim 50, Hogan further teaches that the displayed bill payment information includes a listing of the selected periods (See figure 4); the input device is further configured to receive a user selection of one of the listed selectable periods (see figures 4, 7 and 10); the bill payment area includes a payment period area for displaying the selected period (see figure 10); the processor is further configured to generate the message to authorize payment of the displayed payment amount on the displayed payment date and thereafter at the displayed selected period based on the activation of the payment authorization indicator (i.e. the user selects the due date of the bill amounts that he or she wants to pay and a message is sent authorizing the payment)(see Figure 11).

With respect to claims 41 and 53, Hogan teaches the input device is further configured to receive a user command to change the displayed payment date to a modified payment date (i.e. the user can change the date to another date)(see Figure 4, item 407); the processor is further configured to automatically generate an instruction to change the displayed payment date to the modified payment date, based on the user change command (i.e. when the user chooses another date the display will be modified so that the user can enter a new date)(see Figure 4).

With respect to claim 54, Hogan further teaches that the displayed bill payment information includes a payee area for displaying a payee name, and further comprising receiving a user command identifying a biller (i.e. the user clicks/identify the biller)(Figure 10); and automatically displaying a name of the identified biller as the payee name in the payee area (i.e. the biller identified will be the one displayed)(Figure 11); wherein the bill and the bill payment information are displayed in response to the identification of the biller)(Figures 10-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 35-37, 39-40, 44-45, 47-49, 52 and 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

Claims 35-37, 47, 48, 56 further recite that the payment date pre-dates the displayed payment due date by an amount of time corresponding to a time period for making payment in a particular manner is automatically displayed initially in the payment date area as the payment date. Hogan teaches that the bill is posted and sent as the bill information concerning the subscriber is received and the customer can pay the bill as soon as the bill is received then the payment date pre-dates the due date of

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the bill(see col. 5, lines 53-61 and Figure 4). Hogan does not specifically teach that the payment date corresponds to a time period for making payment in a particular manner. Official notice is taken that it is old and well known in bill paying for billers to specify a time period where they no longer will receive checks but where the only payments accepted will be money orders or cash in order to avoid prolonging the time period of payment. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the payment period to corresponds to a time period for making a payment in a particular manner in order to obtain the above mentioned advantage.

Claim 39 further recites an indicator indicating that the displayed payment amount has been paid. Official notice is taken that it is old and well known to indicate or display an indication that a bill has been paid. For example, when a person makes a deposit or payment through an ATM a display or print out is received showing that the transaction was completed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included an indicator that the displayed amount has been paid in order to obtain the above mentioned advantage.

Claims 40, 45, 52 further recite that the displayed information is displayed in a format of a check and that a cancelled check stamp indicate that the displayed amount has been paid. Hogan teaches on figure 4 item 409 that the customer can opt to pay with a checking account. Hogan is silent as the details of the display when the checking account is selected and indication when the check has been paid. Nevertheless, it would make sense if paying with a check to change the display because such a

modification would allow the customer to interact with a display that he or she is familiar with. An indication of or cancelled check stamp is old and well known to assure the customer that the check has been paid. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a check stamp indicating that the check has been paid in order to obtain the above mentioned advantage.

Claim 44 further recite a portion associated with the displayed bill, another portion corresponding to advertisements and another portion associated with customer care. Hogan teaches a portion associated with the displayed bill and customer care such as grievance(see Figure 4). Hogan does not specifically teach a portion associated with advertisements. Official notice is taken that it is old and well known in bill payments to send advertisements with bills to induce the customers to make purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included including a portion of the bill to include advertisements in order to achieve the above mentioned advantage.

With respect to claim 49, Hogan further teaches that the first type payment mode is payment by check and the second type payment mode is payment by electronic fund transfer (see Figure 4, item 411).

With respect to claim 57, Hogan further teaches that the displayed bill payment information includes a periodic payment area for displaying a periodicity at which further payments of the displayed payment amount are to be made after the displayed payment date (see figure 4, item 411).

Claim 58 further recites an indicator indicating that the displayed payment amount has been paid. Official notice is taken that it is old and well known to indicate or display an indication that a bill has been paid. For example, when a person makes a deposit or payment through an ATM a display or print out is received showing that the transaction was completed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included an indicator that the displayed amount has been paid in order to obtain the above mentioned advantage.

Claim 59 further recites that the displayed information is displayed in a format of a check and that a cancelled check stamp indicate that the displayed amount has been paid. Hogan teaches on figure 4 item 409 that the customer can opt to pay with a checking account. Hogan is silent as the details of the display when the checking account is selected and indication when the check has been paid. Nevertheless, it would make sense if paying with a check to change the display because such a modification would allow the customer to interact with a display that he or she is familiar with. An indication of or cancelled check stamp is old and well known to assure the customer that the check has been paid. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a check stamp indicating that the check has been paid in order to obtain the above mentioned advantage.

With respect to claim 60, Hogan further teaches that the bill payment information includes a payee area for displaying a payee name (see Figure 4).

With respect to claim 61, Hogan further teaches a selectable biller list including a plurality of billers (See Figure 10).

Claim 62 further recite a portion associated with the displayed bill, another portion corresponding to advertisements and another portion associated with customer care. Hogan teaches a portion associated with the displayed bill and customer care such as grievance(see Figure 4). Hogan does not specifically teach a portion associated with advertisements. Official notice is taken that it is old and well known in bill payments to send advertisements with bills to induce the customers to make purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included including a portion of the bill to include advertisements in order to achieve the above mentioned advantage.

Claims 55 and 63 further recites that the displayed information is displayed in a format of a check . Hogan teaches on figure 4 item 409 that the customer can opt to pay with a checking account. Hogan is silent as the details of the display when the checking account is selected. Nevertheless, it would make sense if paying with a check to change the display because such a modification would allow the customer to interact with a display that he or she is familiar with. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displayed information is displayed in a format of a check in order to obtain the above mentioned advantage.

Response to Arguments

6. The double patenting rejections have been withdrawn.
7. With respect to the 101 rejection, the Examiner wants to point out that the body of the claims do not recite any computer or device that would allow to analyze or calculate the bills. Therefore, the 101 rejection has been sustained.
8. Applicant argues that Hogan does not teach "a payment due date" the Examiner respectfully disagree with Applicant because like any Hogan like any bill presentation, shows a payment due date for the bill, so that the payor will know when to make his payments. In addition to Figure 4, see col. 2, lines 21-40 and Figure 11, 1105.
9. Applicant argues that Hogan doesn't teach a payment amount. The Examiner respectfully disagree with Applicant because Hogan like any bill presentation, shows the payment amount due. Figure 4 of Hogan clearly teaches the "total amount now due" , In the case of Figure 4, the \$114.43 is the amount due on the account. The allowed, pre-established partial amounts allow the payor to break into payment the \$114.43 amount. The \$114.43 or the established allowed partial payments are the payment amounts due on the account.
10. Applicant argues that Hogan does not teach a periodic payment area for displaying future payment due dates. The Examiner disagrees with Hogan because Hogan teaches on col. 6, lines 59-64 it teaches that the payee can allow for partial or recurring payments to be displayed, the server computer 160 prompts for the allowed partial payment amount to be displayed when the "allowed partial" is selected.

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11. The Applicant, points the Examiner to different embodiments of Hogan , the Examiner wants to point out that In Dewey & Almy Chem. Co. v. Mimex Co., 124 F.2d 986, 52 USPQ 138 (2d. Cir. 1942, the court stated that "[I]f the claimed invention can be found within the embed of a single prior art reference, then the invention has been anticipated. In this case, although Figures 10 and 11 are associated with the e-mail embodiment, it still teaches a single screen display for a selectable biller.

12. Applicant argues that Hogan doesn't teach displaying the same information in the single screen. The Examiner disagrees with Applicant because Hogan teaches the payment due date, total amount due, and a selectable biller list (see Figure 11). Since, the claims recite a plurality of billers identifiers or a selectable biller list, then the claims are met if either one of the claim limitations is met, in this case, Hogan teaches a selectable biller list (Electric Co.) a list can consist of one item.

13. With regard to the examiner's use of Official Notice, since, Applicant didn't command a response or request of such personal knowledge such as to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned.

14. Applicant argues that Hogan does not teach a customer care indicator. The customer disagrees with Applicant because the "grievance" of Hogan equates to a customer care function when the customer is in disagreement with the amount billed.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

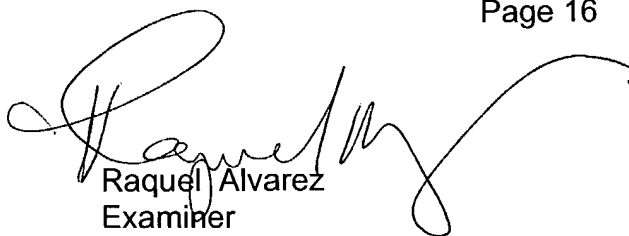
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Raquel Alvarez
Examiner
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R.A.
6/29/04